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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John S. Hendricks

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ARENT FOX LLP

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WASHINGTON, DC 20036

EXAMINER

LANEAU, RONALD

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

03/16/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/964,883	Applicant(s) HENDRICKS, JOHN S.	
	Examiner Ronald Laneau	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-29 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-29 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01212011; 10292010</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on 01/10/11 has been entered. Claims 10-14 and 31-35 are withdrawn, claims 36-40 are added and claims 15-29 and 36-40 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-29 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borsuk (US 5,475,399) in view of Hartrick et al (US 5,532,920).

As per claims 15, 20 and 25, Borsuk discloses a method for providing on-line accounts for purchases of electronic books via a computer (see fig. 5), comprising: storing identifications of a plurality of electronic books on a viewer in a repository accessible by a processor at an operations center (see figs. 1, 5). Borsuk does not explicitly disclose a billing system for subscribers of electronic books but Hartrick discloses providing the electronic books for purchase by subscribers at a user interface functioning via the processor (see abstract). initializing a plurality of home subsystems to create on-line accounts for a subscribers, including transferring subscriber information and a billing account to a billing and collection system for each of the subscribers (col. 3, lines 42-62); maintaining the on-line accounts for the subscribers in the repository (col. 5, lines 14-25); recording via the processor an indication of purchases of the electronic books in the corresponding accounts; associating via the processor an amount of

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each purchase with the source for the corresponding electronic book (col. 11, lines 38-60, see fig. 5); and permitting each of the subscribers to access a corresponding one of the on-line accounts for the subscriber at a user interface functioning via the processor (see fig. 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the billing system as taught by Hartrick into the system of Borsuk because it would provide an improved method for managing the writing of a structured document so as to comply with royalty payment requirements of the documents.

As per claims 16 and 26, Borsuk's system is capable of providing on-line access to a customer service representative for the on-line accounts as claimed (see Borsuk, fig.5; e-book user can go online and will have access to customer service).

As per claims 17-19, 21-24 and 27-29, Hartrick discloses an apparatus wherein the associating step includes associating the amount with a publisher for the corresponding electronic book (col. 5, lines 14-32); wherein the providing step includes electronically communicating with a viewer for use in receiving requests to purchase the electronic books (see abs.); further including charging a subscriber account for the purchases (royalty payment)s; further including generating a bill to one of the subscribers for the purchases (col. 12, lines 33-46).

It would have been obvious to one off ordinary skill in the art at the time the invention was made to utilize the billing system as taught by Hartrick into the system of Borsuk for the same reasons previously given.

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As per claim 36, Borsuk discloses a method further comprising security encoding the plurality of formatted electronic books (see fig. 2, 11; hand held reading unit having a display for displaying encoded text); wherein the plurality of electronic books is received from a plurality of sources having different formats of electronic books, and wherein formatting the electronic books includes converting the electronic books to a standard and a compressed format (encoder 11 can convert text into different formats as claimed).

As per claims 38 and 39, Borsuk discloses a method wherein the plurality of sources includes at least one selected from a group consisting of a publisher, a newspaper, and an on-line service (see fig. 5; handheld reading unit 1 is connected to a computer that has access to publishers and on-line service); wherein the plurality of sources includes a plurality of publishers (handheld 1 of figure 5 has access to a plurality of publishers as claimed).

As per claim 40, a method of claim 15, Hartrick discloses a method further comprising: receiving an indication of purchases of the electronic books via a combined cable and telephone switching system (col. 11, lines 38-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize method of purchases as taught by Hartrick into the system of Borsuk for the same reasons previously given.

Response to Arguments

4. Applicant's arguments filed 01/10/11 have been fully considered but they are not persuasive.

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Applicant argues that Borsuk discloses nothing regarding providing electronic books to subscribers for purchase. Contrary to Applicant's arguments, Hartrick is used to disclose that a user has the option of paying a royalty to the publisher before said user can access a copy of the book to be read (see above rejection). Applicant further argues that Hartrick does not disclose or suggest "initializing or maintaining on-line accounts at all." In response to Applicant's arguments this is obvious for the system of Hartrick. A user needs to create an on-line account and put his/her personal information into the system before said user can pay the royalty. The user's account must be in good standings in order to perform the act of accessing an information from a publisher. A user needs to first subscribe through a user interface and makes the purchase. The combination of Borsuk with Hartrick is reasonable and appears to disclose Applicant's invention as claimed. As a result, claims 15-29 and 36-40 are finally rejected.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571)272-6784. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lewis can be reached on (571) 272-7673. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald Laneau/
Primary Examiner
Art Unit 3714

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